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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/349,479 12/02/94 BORDER

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EXAMINER

GAMBEL, P

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

09/15/00

67

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/349479

Applicant(s)

~~GAMBEL~~ RUOSUUTTEL.

Examiner

GAMBEL

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/10/00
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 11, 12, 21-23, 25 is/are pending in the application.
- ☐ Of the above claim(s) 11, 12 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 21-23, 25 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

1. Applicant's amendment, filed 5/10/00 (Paper No. 66), is acknowledged.

Claims 21-23 and 25 are being acted upon as the elected invention presently.

Claims 11 and 12 have been withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention.

Claims 1-10, 13-20, 24, 26-34 have been canceled previously.

2. The text of those sections of Title 35 USC not included in this Action can be found in a prior Action. This Office Action will be in response to applicant's arguments, filed 5/10/00 (Paper No. 66). The rejections of record can be found in the previous Office Action (Paper No. 63).
3. Formal drawings and photographs have been submitted which fail to comply with 37 CAR 1.84. Please see the form PTO-948 previously sent in Paper No. 11.

Applicant's amendment, filed 5/10/00 (Paper No. 66), indicates that applicant will defer responding until allowable subject matters is indicated.

4. Upon reconsideration of applicant's arguments and evidence, filed 5/10/00 (Paper No. 66); the previous rejection under 35 U.S.C. 112, first paragraph, has been withdrawn.

5. Claims 21, 23 and 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dasch et al. (U.S. Patent No. 5,772, 1998; 1449) for the reasons of record set forth in Paper No. 63.

6. Claims 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dasch et al. (U.S. Patent No. 5,772,998; 1449) in view of Ruoslahti et al. (U.S. Patent No. 5,583,103) AND/OR Bassols et al. (J.Biol. Chem. 263: 3039-3045, 1988; of record, 1449) for the reasons of record set forth in Paper No. 63..

7. Applicant's arguments, filed 5/10/00 (Paper No. 66), in conjunction with the Border/Ruoslahti declaration under 37 C.F.R. § 1.131, filed 8/30/99 (Paper Nos. 60/62), have been fully considered but are not found convincing essentially for the reasons of record set forth in Paper No. 63.

Applicant argues in conjunction with Ex parte Ovshinsky that the 131 Declaration is sufficient to antedate the Dasch et al. prior art reference and that "an accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself".

Applicant asserts that the Rouslahti/Border Declaration explicitly states that the inventors contemplated prior to 12/22/88 that anti-TGFβ antibody could bind to and inhibit TGFβ to treat pathologies and that there is no requirement to produce additional exhibits that establish applicant's conception of therapeutic methods.

Applicant relies upon the provision of five Exhibits with the 131 Declaration that are consistent with averments of conception of the claimed therapy methods prior to 12/22/88.

In addition, applicant provides Exhibit 5, a conference Abstract published for the Meeting of the American Society of Nephrology in San Antonio, Texas; which took place from 12/11-14/88. Here, applicant asserts that the reference lists Border/Ruoshlahti as first and senior authors and clearly articulates applicant's conception of treating pathologies related to TGF β -mediated accumulation of extracellular matrix prior to 12/22/88.

Also, applicant submit that applicant's averments in the 131 Declaration and corresponding Exhibits show conception of the invention prior to the effective date of Dasch et al. (12/22/88) coupled with applicant's due diligence from prior to 12/22/88 until the filing date of the instant application.

Applicant asserts that there is no requirement for applicant to establish via extrinsic evidence a link between the experiments aimed at inhibiting deleterious extracellular matrix accumulation and the claimed therapeutic methods.

Applicant reliance upon Exhibits subsequent to 12/22/88 for due diligence in their effort leading up to the filing of the above-identified application is acknowledged.

Applicant relies upon Exhibits which show the protocol for developing rabbit anti-TGF β antiserum and which characterize the ability of TGF β inhibitory agents (decorin and biglycan) to decrease the secretion and accumulation of ECM components in a rat glomerular culture experimental model as consistent with the conception of the claimed invention.

Applicant further submit that the ability of anti-TGF β (as well as RGD and PDGF)) to inhibit the secretion of proteoglycans in the rat glomerulat culture models directly relate to testing agents that could bind to TGF β in a tissue and inhibit TGF β effects to treat pathologies.

It is acknowledged that Ex parte Ovshinsky and MPEP 715.07 indicate that the accompanying Exhibit(s) need not support all claimed limitations provided that any missing limitation is supported by the Declaration itself.

Also, it is noted that Ovshinsky also relies upon Ex parte Swaney 89 USPQ 618 (BPAI 1951); which indicates that the Declaration in addition to the Exhibits were sufficient in content and scope to render the prior art unavailable as a reference against the claims. Here in Swaney; the Declaration supplied a condition that the submitted evidence failed to express, that is, the missing element was actually performed in the Exhibits. Therefore, the evidence of the Declaration/Exhibits clearly had reduced the invention to practice before the filing date of the prior art in question. .

In contrast, the 131 Declaration is extending the teachings of the Exhibits, which are drawn to characterize the role of TGF β in regulating extracellular glomerular matrix production, to the claimed methods of decreasing the deleterious accumulation of extracellular matrix associated with a pathology with TGF β -specific antibody; encompassing scarring, glomerulonephritis, ARDS and liver cirrhosis.

Therefore, applicant's evidence that precedes the priority date of the prior art references is not sufficient in content and scope to render the prior art unavailable as a reference against the instant claims.

The following is of record and reiterated herein for applicant's convenience.

While applicant has provided evidence/Exhibits to indicate prior conception to the prior art as it would read on Dasch et al. (U.S. Patent No. 5,772,998; 1449) above; it does not provide sufficient objective evidence to establish acts in this country commensurate in scope with the claimed invention. For example, development of rabbit anti-TGF- β antiserum (Exhibit A), experiments to characterize the role of TGF- β in experimental models of glomerulonephritis (Exhibit B); a letter between the inventors concerning the role of RGD/PDGF on TGF- β (Exhibit C); sections of a grant Proposal on treating Glomerular disease from January 1989 (Exhibit D) and a draft manuscript subsequent to the Grant Proposal (Exhibit E).

Here, it has been noted that the priority date of Dasch et al. (U.S. Patent No. 5,772,998) is December 1988 and that the priority dates of Ruoslahti et al. (U.S. Patent No. 5,583,103) and Bassols et al. (J. Biol. Chem. 263: 3039-3045, 1988) are more than one year prior to applicant's priority date.

Applicant's reliance on reagents other than the claimed anti-TGF- β antibodies are not found convincing as supporting the conception, diligence and reduction of practice to the claimed methods of employing said anti-TGF- β antibodies to decrease the deleterious accumulation of extracellular matrix, recited in the instant claims.

With respect to the alleged evidence prior to December 1998; it appears that this evidence is directed toward characterizing the role of TGF- β in certain aspects of glomerular disease and not on the content and scope of the claimed methods (e.g. methods of decreasing the deleterious accumulation of ECM associated with pathologies and conditions, including ARDS, cirrhosis, scarring). With respect to glomerulonephritis, it does not appear that applicant's evidence supports the use of anti-TGF- β -specific antibodies to inhibit the deleterious accumulation of ECM associated with glomerulonephritis were conceived and reduced to practice previous to the priority dates of the current art rejection under 35 USC 103 set forth above. Also, while applicant has provided notebook pages as evidence of conception, diligence and reduction to practice; these pages together with the comments in the Border/Ruoslahti declaration are not clear on their face. Applicant has the burden to explain the contents of the pages as proof of acts amounting to conception, diligence and reduction to practice. See In re Borkowski and Van Venrooy 184 USPQ 29 (CCPA 1974). Absent a clear explanation of pointing out exactly what facts are established therein and relied upon by applicant, the laboratory notebook pages provide insufficient assistance in enabling the PTO to determine applicant's assertions of conception, diligence and reduction to practice before the prior art as it reads on methods of decreasing the deleterious accumulation of ECM associated with pathologies and conditions, including glomerulonephritis previous to the effective dates of the prior art references.

Applicant's arguments in conjunction with the Border/Ruoslahti declaration under 37 C.F.R. § 1.131 declaration have not been found persuasive.

If the Grant Proposal on treating Glomerular disease from January 1989 (Exhibit D) is sufficient to render Dasch et al. Unavailable as prior art; applicant is invited to consider providing a draft of this Grant Proposal which might precede the 102(e) priority date of Dasch et al., as evidence if it exists.


8. No claim is allowed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.


Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
September 14, 2000